

REMARKS

In an Office Action mailed on February 3, 2003, an objection was made to claim 1; claims 1-8 and 19 were rejected under 35 U.S.C. § 112, second paragraph; claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonnefoy in view of European publication EP 782209 (herein called the "European Application"). Claim 1 has been amended, as suggested by the Examiner, to overcome the objection to claim 1. The §§ 112 and 103 rejections are discussed in the following sections below.

§ 112 Rejections:

The Examiner rejects claims 1-8 and 19 due to the inclusion of the limitations "some of the power being consumed" and "some of the power produced." The Examiner states that "there is insufficient antecedent basis for this limitation in the claim." Final Office Action, 3. However, contrary to the Examiner's contention, claim 1 provides antecedent basis for both of these phrases. Although Applicant submits that claim 1, as currently written, provides proper antecedent basis, claim 1 has been amended to more positively recite the claimed invention so that the § 112 rejections may be overcome for purposes of expediting prosecution.

As amended, claim 1 recites providing a fuel flow to the fuel cell stack to produce power, and in lines 2-3, claim 1 recites that at least some of the power that is produced by the fuel cell stack is consumed by a first load. Thus, lines 2-3 set forth a power that is produced by the fuel cell stack and sets forth that at least some of this power that is produced by the fuel cell stack is consumed by a first load, thereby defining "power produced by the fuel cell stack" and "power consumed by the first load" for the latter recitation of these phrases in subsequent lines of claims 1, 2 and 19. Therefore, it is submitted that claim 1 overcomes the § 112 rejection due to the alleged lack of antecedent basis.

The Examiner also rejects claims 1-8 and 19 under 35 U.S.C. § 112, second paragraph because "it is also uncertain as what particular degree or magnitude of power consumed or produced the instant claims are also intended to recite." Final Office Action, 3. However, this is not a proper basis for a § 112, second paragraph rejection. In this manner, the second

paragraph of 35 U.S.C. § 112 is directed to two separate requirements: (1) the claims must set forth the subject matter that Applicants regard as their invention, and (2) the claims must particularly point out distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. M.P.E.P. § 2171. The Examiner has not shown why claim 1, as currently written, does not meet these two requirements. It appears the Examiner is rejecting claim 1 due to its breadth. However, claim breadth is not to be equated with indefiniteness. M.P.E.P. § 2173.04.

Thus, withdrawal of the § 112 rejections of claims 1-8 and 19 is requested.

§ 103 Rejections:

As pointed out in the last Reply, the Examiner fails to establish a *prima facie* case of obviousness for at least the reason that the Examiner provides no support for the alleged suggestion or motivation to combine the European Application with Bonnefoy. In response to this argument, the Examiner states that "in this case, both references are directed to method of operating fuel cell system exhibiting changeable load conditions." Final Office Action, 10. However, even assuming, *arguendo*, that both references have circuits that supply power to changeable loads, the Examiner must show specific support (with specific citations) for the alleged suggestion or motivation to combine Bonnefoy and the European Application. . *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. Although the Examiner's statement supports a conclusion that the two cited references may be analogous art, the Examiner has provided no support for the alleged suggestion or motivation to combine the European Application with Bonnefoy.

Therefore, for at least this reason, a *prima facie* case of obviousness has not been established for claims 1-8 and 19. Furthermore, the Examiner fails to show support for any suggestion or motivation to modify Bonnefoy to derive the missing claim limitations that are not taught by either reference, as further discussed below.

The Examiner contends that Bonnefoy *inherently* teaches the determining act of claim 1. As pointed out in the last Reply, claim 1 sets forth determining whether to route at least some of the power that is produced by the fuel cell stack and is not consumed by the first load to a second load. In contrast, Bonnefoy teaches routing *all* excess energy to a battery.

For a limitation to be inherent in a reference, the missing claim limitation must *necessarily flow* from the reference. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Not only does the Examiner fail to show why the missing claim limitation necessarily flows from Bonnefoy, Bonnefoy in fact teaches an alternative: routing *all* excess energy to a battery instead of making such a determination on whether to route this energy or not. Therefore, Applicant has no burden to rebut the inherency contention by the Examiner because the Examiner has failed to establish why the missing claim limitation necessarily flows from Bonnefoy, and a clear alternative may be used.

Additionally, a *prima facie* case of obviousness has not been established for claims 1-8 and 19 because neither Bonnefoy nor the European Application teaches or suggests selectively routing at least some of the power that is produced by the fuel cell stack and is not consumed by the first load to the second load. The Examiner admits this limitation is not present in Bonnefoy and refers to language in the European Application (for example, language in lines 18-23 on page 4 and lines 24-29 on page 4) that relates to a turns ratio of a transformer. However, this language neither teaches nor suggests the selective routing act of claim 1. Therefore, for at least this additional, independent reason, the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-8 and 19.

CONCLUSION

In view of the foregoing, Applicant requests withdrawal of the §§ 112 and 103 rejections and a favorable action in the form of Notice of Allowance. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (PUG.0056US).

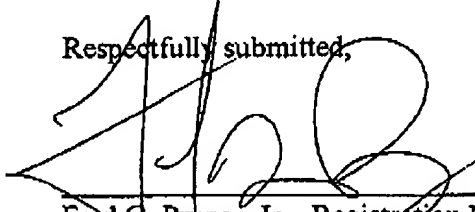
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PATENT TRADEMARK OFFICE

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